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09/736,364	12/15/2000	Pierre Hercules Nel	3777-8	8933

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EXAMINER

CHARLES, DEBRA F

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/736,364

Applicant(s)

NEL, PIERRE HERCULES

Examiner

Debra F. Charles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 33-50 and 52-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-50 and 52-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Terminal Disclaimer***

1. The terminal disclaimer filed on 10 October 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. PAT. 6507823A has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Response to Amendment***

2. Claims 33,34,40,42,43,44,47,48,49,50,52,53,56,57,59,60,61 and 63 have been amended. Claim 51 has been cancelled.

### ***Response to Arguments***

3. Applicant's arguments filed 10 October 2003 have been fully considered but they are not persuasive. The applicant's argument that Shavit's invention differs from the applicant's invention because the applicant is now using ATM machines rather than the remote intelligent terminals of Shavit is not patentably distinct and Hale does indeed teach a multi-functional terminal that provides more than merely cash deposit and withdrawal. Further, nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 33,34,36,38,48,49,50,53,57,58,60 and 63 are rejected under 35 U.S.C. 102(b) as being anticipated by Shavit et al.(U.S. PAT. 4799156 A).

Re claims 33,49,50,53 and 63: Shavit et al. disclose a method of conducting a financial transaction between an individual purchaser and a vendor of a product, (Abstract) the method comprising the steps of:

utilizing a computerized banking system comprising a plurality of financial institutions(Fig. 1); each of said plurality of financial institutions comprising a computer center processing information relating a plurality of computer based client accounts(col. 4, lines 27-49), an electronic banking network interconnecting said financial institutions(Fig. 2, col. 15, lines 18-36); and a plurality of automatic teller machines(Fig. 2) connected to said network;

utilizing at least one vendor database including product related information connected to the said network(col. 14, line 63-col. 15, line 44);

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providing product-related information to an individual purchaser via one of said automatic teller machines(col. 14, line 50-col. 15, line 60); communicating to the vendor database via the network product related information regarding a product required by an individual purchaser and which information is provided by an individual purchaser via one of said automatic teller machines(col. 15, line 45-col. 16, line 29); and authorizing payment by an individual purchaser for the product purchased(col. 8, lines 55-67).

Re claims 34 and 48: Shavit et al. disclose a method of conducting a financial transaction between an individual purchaser and a vendor of a product(Abstract), an individual purchaser and the vendor being associated with respective first and second accounts held at respective first and second financial institutions(Fig. 2), the method comprising the steps of:

utilizing at least one vendor database including product-related information; linking a data exchange automatic teller machine to the at least one vendor database via a data network linking said first and second financial institutions(Fig. 2, col. 14, line 63-col. 15, line 44);

obtaining transaction-related information regarding a product required from the purchaser via the automatic teller machine(col. 16, line 11-49);

communicating the transaction-related information via the network to the vendor database(col. 14, line 50-col. 15, line 17); and

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initiating an electronic transfer of funds from the first account to the second account for the value of the transaction(col. 14, lines 50-63, col. 8, line 55 to col. 9).

Re claims 36 and 38: Shavit et al. disclose wherein the transferring of funds electronically involves debiting the first account and crediting the second account performed in real time(col. 14, lines 50-63, col. 8, line 55-col. 9, line 6).

Re claim 57: Shavit et al. disclose the data output of the data exchange automatic teller machine includes a screen, and the system software includes menu drivers for producing enquiry menus on the screen using which an individual purchaser provides transaction-related information via the data input of the data exchange automatic teller machine to the system(col. 6, lines 20-50, col.10, lines 45-67).

Re claim 58: Shavit et al. disclose the enquiry menus include icons associated with transaction options, and an individual purchaser is able to select a transaction option by selecting an icon using the data input(col. 6, lines 20-50, col.10, lines 45-67, col. 12, lines 40-67).

Re claim 60: Shavit et al. disclose the data exchange automatic teller machine includes a printer which issues a record of the transaction or a voucher which serves as proof of the transaction(col. 16, lines 30-49).

***Claim Rejections - 35 USC § 103***

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 35, 39, 43, 44, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit et al.(U.S. PAT. 4799156 A).

Re claim 35: Shavit et al. do not explicitly disclose wherein the first and second financial institutions comprise the same financial institution. However, businesses and consumers or purchasers do share the same bank in many business transactions. Thus, it would have been obvious to one with an ordinary level of skill in the art to employ the same financial institution for transactions between two counterparties to get the benefit of speeding the transaction since transactions on the same institution clear on the same day.

Re claim 39: Shavit et al. do not explicitly disclose(s) the funds are transferred electronically between the first and second account at a predetermined future time. However, financial institutions routinely provide credits to an individual purchaser and obtain funds at a later time from customer's account whenever a previous agreement was made. Thus, it would have been obvious to one with an ordinary level of skill in the art to employ scheduling transactions ahead of time to get the benefit of automated

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transactions that implement on schedule without customer action each time a transaction must be performed.

Re claim 43: Shavit et al. disclose(s) the claimed invention except the transaction-related information includes at least product identification information, the value of the product and details of at least one account associated with funds are to be electronically transferred.

However, most products sold as those found in a catalog include a product identification number for easy selection and identification to/by a user. Thus, it would have been obvious to one with an ordinary level of skill in the art to employ product identification numbers to get the benefit of quickly identifying the product without a lengthy description.

Re claim 44: Shavit et al. disclose(s) the claimed invention except verifying the availability of funds in the account, the availability of at least one of (a) vendor product and (b) the qualification of an individual purchaser to perform the transaction before conclusion of the transaction. However, performing these steps before the conclusion of the transaction would have been obvious to one with an ordinary level of skill in the art to ensure that sufficient payments are made to the appropriate vendor selling a particular product/service.

Re claims 45 and 46: Shavit et al. disclose including the step of printing a record of the transaction which serves as proof of the transaction. And the step of printing a voucher relating to the transaction which serves as proof of the transaction(col. 16, lines 30-49).



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8. Claims 37,40-42, 47 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit et al. and Hale et al.(U.S. PAT. 4689478).

Re claims 37 and 40-41: Shavit et al. disclose(s) the claimed invention except the step of obtaining a code from an individual purchaser to verify authorization of the transaction and enquiry menus. However, in col. 11, lines 50-65,col. 12, lines 25-65 thereof, Hale et al. disclose(s) using a PIN for providing /verifying authorization of the transactions. Thus, it would have been within the level of ordinary skill in the art to modify the method of Shavit et al. by adopting the teachings of Hale et al. The motivation to combine these references is to obtain enhanced security and authentication functionality in the transaction process.

Re claim 42: Shavit et al. disclose the steps of displaying at least part of the product-related information of the display, and updating the product-related information at least one of (a) in real time response and (b) on the occurrence of a transaction between an individual purchaser and the vendor(col. 14, line 63-col. 15,line 60).

Re claim 47: Shavit et al. disclose(s) the claimed invention except the step of reading an indicator at the automatic teller machine, the indicator being configurable by an individual purchaser to indicate the transaction-related information. However, in col. 13, lines 45-67 thereof, Hale et al. disclose(s) line display shows the user's current VISA balance for charges and line display shows how the user's balance will increase by the intended purchase, permitting the user to change the data. Thus, it would have been within the level of ordinary skill in the art to modify the method of Shavit et al. by

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adopting the teachings of Hale et al. The motivation to combine these references is to obtain the flexibility of allowing the customer to change certain indicated items.

Re claim 52: Shavit et al. disclose(s) the claimed invention except the data exchange automatic teller machine is a bank service automatic teller machine. And the communication system comprises an ATM network to which the data exchange automatic teller machine, the at least one vendor database, and the first and second financial institutions are linked to facilitate the communication there between.

However, in col. 1, lines 35-40 thereof, Hale et al. disclose(s) ATM network automatic teller machines. Thus, it would have been within the level of ordinary skill in the art to modify the method of Shavit et al. by adopting the teachings of Hale et al. The motivation to combine these references is to obtain the advantage of using an ATM machine for transactions.

9. Claims 54,55,56, 61 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit et al. and Bush(U.S. PAT. 5475585 A).

Re claims 54,55,61 and 62: Shavit et al. disclose(s) the claimed invention except a portable storage device adapted to store product-related information and/or at least part of the system software and/or transaction records. And wherein the portable storage device comprises a smart card. However, in Fig. 7B, items 234 and 236,col. 7, lines 22-35 thereof, Bush disclose(s) smart card reader and credit card reader. Thus, it would have been within the level of ordinary skill in the art to modify the method of Shavit et al.

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by adopting the teachings of Bush. The motivation to combine these references is so that customer's transaction data may be automatically recorded and compiled for future viewing/analyzing.

Re claim 56: Shavit et al. disclose wherein the product-related information is accessible via a data output means of the data exchange automatic teller machine and is updatable at least one of (a) in real time and (b) on the occurrence of a transaction between an individual purchaser and the vendor(Fig. 8, col. 6, lines 20-50, col. 7, lines 55-col. 8, line25).

10. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit et al. and Lawlor et al.(U.S. PAT. 5220501 A).

Shavit et al. disclose(s) the claimed invention except the communication system includes at least one of (a) conventional telephone lines and (b) dedicated communication lines and an interface which allows the at least one vendor database to communicate with the data exchange automatic teller machine utilizing established ATM message protocols. However, Abstract and in col. 4, lines 25-36 thereof, Lawlor et al. disclose(s) ATM protocols and standards. Thus, it would have been within the level of ordinary skill in the art to modify the method of Shavit et al. by adopting the teachings of Lawlor et al. The motivation to combine these references is to obtain standardized protocols throughout the ATM network to ensure freeflow of network communication data.

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11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (703) 305-4718. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (703) 308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

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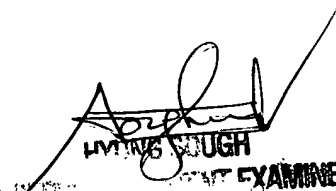
Debra F. Charles

Examiner

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dfc

December 29, 2003

  
SUPERVISOR  
TECHNICAL EXAMINER